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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/180,011	10/29/98	LOOPSTRA	E PH098004

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MM92/0802

EXAMINER

KIM.P

ART UNIT	PAPER NUMBER
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2851

DATE MAILED: 08/02/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/180,011

Applicant(s)  
Loopstra et al.

Examiner  
PETER KIM

Group Art Unit  
2851



☒ Responsive to communication(s) filed on Jun 29, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-11 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-11 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### DETAILED ACTION

1. Applicant's arguments filed on 6/29/00 (paper #7) have been fully considered.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Hasebe et al. (Hasebe).

Hasebe discloses a positioning device with a guiding surface and a first and second object holder. Hasebe discloses displacement units where the first displacement unit places an object in an intermediate position from a first position and the second displacement unit places the object into a second position.

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Akimoto.

Akimoto discloses in column 4, line 61 through column 5, line 65, a positioning device with a guiding surface and a first (ref. 21) and second (ref. 61) object holder. Akimoto discloses displacement units where the first displacement unit places an object in an intermediate position (ref. 51) from a first position and the second displacement unit places the object into a second position.

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5. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Loopstra et al. (Loopstra).

Loopstra discloses in Figures 4 and 5, the claimed invention.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akimoto in view of Lin.

Akimoto discloses in column 4, line 61 through column 5, line 65, a positioning device with a guiding surface and a first (ref. 21) and second (ref. 61) object holder. Akimoto discloses displacement units where the first displacement unit places an object in an intermediate position (ref. 51) from a first position and the second displacement unit places the object into a second position. However, Akimoto does not disclose a lithographic device with a radiation source, a mask holder, a focusing unit, a characterization unit and a positioning device. Akimoto also does not disclose displacement unit comprising X- and Y- motors. Lin discloses a lithographic device with a radiation source, a mask holder, a focusing unit, a characterization unit and a positioning device. Lin also discloses X- and Y- motors to move the object holders. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to

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provide the X- and Y- motors of Lin to the invention of Akimoto in order to displace the object holders.

8. Claims 2, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe et al. (Hasebe) in view of Lim.

Hasebe discloses a positioning device with a guiding surface and a first and second object holder. Hasebe discloses displacement units where the first displacement unit places an object in an intermediate position from a first position and the second displacement unit places the object into a second position. However, Hasebe does not disclose a lithographic device with a radiation source, a mask holder, a focusing unit, a characterization unit and a positioning device. Akimoto also does not disclose displacement unit comprising X- and Y- motors. Lin discloses a lithographic device with a radiation source, a mask holder, a focusing unit, a characterization unit and a positioning device. Lin also discloses X- and Y- motors to move the object holders. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the X- and Y- motors of Lin to the invention of Hasebe in order to displace the object holders.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5,969,441. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the current application and the prior art claim a positioning device and a lithographic device comprising the positioning device. Although the claims of the current invention claim motors while the claims of the prior art claim force actuator, motor is a type of a force actuator. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide use a motor as a force actuator in the invention of the prior art in order to move the object holders.

***Remarks***

11. Applicant is reminded of the following excerpt from the MPEP.

706.02(b) Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication or Patent Rejection based on 35 U.S.C. 102(e)

The rejection can be overcome by:

- (1) Persuasively arguing that the claims are patentably distinguishable from the prior art;
- (2) Amending the claims to patentably distinguish over the prior art;

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(3) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another." See MPEP § 715.01(a), § 715.01(c), and § 716.10;

(4) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent\*\*>(or application in the case of a provisional rejection)< claiming the same patentable invention as defined in 37 CFR 1.601(n). See MPEP § 715 for more information on 37 CFR 1.131 affidavits. When the claims of the reference and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR 1.131 is not an acceptable method of overcoming the rejection \*\*. Under these circumstances, the examiner must determine whether a double patenting rejection or interference is appropriate. If there is a common assignee or inventor between the application and patent, a double patenting rejection must be made. See MPEP § 804. If there is no common assignee or inventor and the rejection under 35 U.S.C. 102(e) is the only possible rejection, the examiner must determine whether an interference should be declared. See MPEP Chapter 2300 for more information regarding interferences; \*

(5) Perfecting a claim to priority under 35 U.S.C. 119(a) - (d). The foreign priority filing date must antedate the reference and be perfected. The filing date of the priority document is not perfected unless applicant has filed a certified priority document in the application (and an English language translation, if the document is not in English) (see 37 CFR 1.55) and the examiner has established that the priority document satisfies the enablement and description requirements of 35 U.S.C. 112, first paragraph; >or<

(6) Perfecting priority under 35 U.S.C. 119(e) by amending the specification of the application to contain a specific reference to a provisional application in accordance with 37 CFR 1.78(a)(4).

#### *Conclusion*

12. All claims are rejected.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Kim whose telephone number is (703) 305-0105. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays during the same hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams, can be reached on (703) 308-2847. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

  
PBK

7/31/00

  
Russell Adams  
Primary Examiner